

## **REMARKS**

### **I. Introduction**

Claims 1 to 3, 9, and 11 to 23 are pending and being considered. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 1 to 3, 9, 11 to 15, 18 to 20, and 22 Under 35 U.S.C. § 103(a)**

Claims 1 to 3, 9, 11 to 15, 18 to 20, and 22 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 4,372,092 (“Lopez”) and U.S. Patent No. 5,743,056 (“Balla-Goddard et al.”). It is respectfully submitted that the combination of Lopez and Balla-Goddard et al. does not render unpatentable the presently pending claims for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). Further, the Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. M.P.E.P. §2143.

Claim 1 relates to a modular building system, comprising (a) *multiple portable pre-cast modules*, wherein each of the multiple modules include (i) structural steel mesh; (ii) cementitious mortar encasing the structural steel mesh; and (iii) *tapered indentations located along edges of the module and exposing portions of the structural steel mesh*; (b) metal plate connectors; and (c) *welds between the metal plate connectors and the exposed portions of the structural steel mesh thereby connecting adjacent modules*, in which *the tapered indentations located along edges of the adjacent modules are aligned with each other, the metal plate connectors and the welds are situated in the aligned tapered indentations of the adjacent modules, and the adjacent modules form a wall.*



The combination of Lopez and Balla-Goddard et al. does not disclose all of the features included in claim 1. In this regard, Lopez does not disclose the feature of *tapered indentations located along edges of the module and exposing portions of the structural steel mesh*. Indeed, the Office Action at page 2 admits that “Lopez does not disclose tapered indentations.” Further, Lopez merely refers to connecting welding plates 18 to each other at corners 11 of a panel 10. (Lopez, col. 4, lines 58 to 63; and Figure 6). Thus, since Lopez does not disclose tapered indentations, Lopez also does not disclose the features of *welds between the metal plate connectors and the exposed portions of the structural steel mesh thereby connecting adjacent modules*, in which *the tapered indentations located along edges of the adjacent modules are aligned with each other*, *the metal plate connectors and the welds are situated in the aligned tapered indentations of the adjacent modules*, and *the adjacent modules form a wall*.

The Office Action refers to Balla-Goddard et al. as assertedly disclosing the feature of “tapered indentations for connecting adjacent modules.” In this regard, Balla-Goddard et al. merely refers to a panel having opposed sides with complementary male/female shape, such as “intermeshing toothed shape ..., wavy shape or tongue-and-groove shape.” (Balla-Goddard et al., col. 3, lines 7 to 10; and Figures 6 and 7). Thus, a male shape on one side of a panel intermeshes with a female shape on one side of an adjacent panel. However, nowhere does Balla-Goddard et al. disclose the feature of tapered indentations located along edges of the module and exposing portions of the structural steel mesh. Moreover, since Balla-Goddard et al. merely refers to a panel having opposed sides with complementary male/female shape, Balla-Goddard et al. does not disclose the feature that *the tapered indentations located along edges of the adjacent modules are aligned with each other*. Further, Balla-Goddard et al. merely describes a lock and rebate system 72 for securing adjacent panels together. (Balla-Goddard et al., col. 7, lines 43 to 52). Thus, nowhere does Balla-Goddard et al. disclose the features of welds between the metal plate connectors and the exposed portions of the structural steel mesh thereby connecting adjacent modules, and the metal plate connectors and the welds are situated in the aligned tapered indentations of the adjacent modules.

Accordingly, the combination of Lopez and Balla-Goddard et al. does not disclose, or even suggest, the features of *tapered indentations located along*



*edges of the module and exposing portions of the structural steel mesh, and welds between the metal plate connectors and the exposed portions of the structural steel mesh thereby connecting adjacent modules, in which the tapered indentations located along edges of the adjacent modules are aligned with each other, the metal plate connectors and the welds are situated in the aligned tapered indentations of the adjacent modules, and the adjacent modules form a wall, as provided for in the context of claim 1.*

Accordingly, it is respectfully submitted that the combination of Lopez and Balla-Goddard et al. does not disclose, or even suggest, all of the features included in claim 1. Therefore, it is respectfully submitted that the combination of Lopez and Balla-Goddard et al. does not render unpatentable claim 1 for at least the foregoing reasons.

Thus, as for claims 2, 3, 9, 11 to 15, 18 to 20, and 22 which ultimately depend from claim 1 and therefore include all of the features included in claim 1, it is respectfully submitted that the combination of Lopez and Balla-Goddard et al. does not render unpatentable these dependent claims for at least the reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

### **III. Rejection of Claims 2, 16, 17, and 23 Under 35 U.S.C. § 103(a)**

Claims 2, 16, 17, and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Lopez, Balla-Goddard et al., and U.S. Patent No. 7,121,061 ("Jazzar"). It is respectfully submitted that the combination of Lopez, Balla-Goddard et al., and Jazzar does not render unpatentable the presently pending claims for at least the following reasons.

Claims 2, 16, 17, and 23 ultimately depend from claim 1. As more fully set forth above, the combination of Lopez and Balla-Goddard et al. does not disclose, or even suggest, all of the features included in claim 1. Jazzar also does not disclose, or even suggest, all of the features included in claim 1, and thus, fails to cure this critical deficiency.

Accordingly, it is respectfully submitted that the combination of Lopez, Balla-Goddard et al., and Jazzar does not disclose, or even suggest, all of the features included in claim 1, from which claims 2, 16, 17, and 23 ultimately depend.



As such, it is respectfully submitted that the combination of Lopez, Balla-Goddard et al., and Jazzar does not render unpatentable claims 2, 16, 17, and 23, which ultimately depend from claim 1.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**IV. Rejection of Claim 3 Under 35 U.S.C. § 103(a)**

Claim 3 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Lopez, Balla-Goddard et al., and U.S. Patent No. 4,930,677 (“Jolliffie”). It is respectfully submitted that the combination of Lopez, Balla-Goddard et al., and Jolliffie does not render unpatentable the presently pending claim for at least the following reasons.

Claim 3 depends from claim 1. As more fully set forth above, the combination of Lopez and Balla-Goddard et al. does not disclose, or even suggest, all of the features included in claim 1. Jolliffie also does not disclose, or even suggest, all of the features included in claim 1, and thus, fails to cure this critical deficiency.

Accordingly, it is respectfully submitted that the combination of Lopez, Balla-Goddard et al., and Jolliffie does not disclose, or even suggest, all of the features included in claim 1, from which claim 3 depends. As such, it is respectfully submitted that the combination of Lopez, Balla-Goddard et al., and Jolliffie does not render unpatentable claim 3, which depends from claim 1.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

**V. Rejection of Claim 21 Under 35 U.S.C. § 103(a)**

Claim 21 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Lopez, Balla-Goddard et al., Jazzar, and Jolliffie. It is respectfully submitted that the combination of Lopez, Balla-Goddard et al., Jazzar, and Jolliffie does not render unpatentable the presently pending claim for at least the following reasons.

Claim 21 depends from claim 1. As more fully set forth above, the combination of Lopez and Balla-Goddard et al. does not disclose, or even suggest, all of the features included in claim 1. Jazzar and Jolliffie also do not disclose, or



even suggest, all of the features included in claim 1, and thus, fail to cure this critical deficiency.

Accordingly, it is respectfully submitted that the combination of Lopez, Balla-Goddard et al., Jazzar, and Jolliffee does not disclose, or even suggest, all of the features included in claim 1, from which claim 21 depends. As such, it is respectfully submitted that the combination of Lopez, Balla-Goddard et al., Jazzar, and Jolliffee does not render unpatentable claim 21, which depends from claim 1.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

## **VI. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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